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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,085	07/20/2001	Kenneth B. Higgins	5113A	2412

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Milliken & Company
P.O. Box 1927
Spartanburg, SC 29304

EXAMINER

JUSKA, CHERYL ANN

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/910,085

Applicant(s)

HIGGINS ET AL.

Examiner

Cheryl Juska

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-51,54,55,57-85,89-100,103-106,109-112,114,119,122 and 143 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 3-51, 54, 55, 57-85, 89-100, 103-106, 109-112, 114, 119, 122, and 143 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed November 28, 2005, has been entered. Claims 1, 41, 50, 55, 58, 95, 106, and 109-112 have been amended as requested. Claims 2, 52, 53, 56, 86-88, 101, 102, 107, 108, 113, 115-118, 120, 121, and 123-142 have been cancelled. Thus, the pending claims are 1, 3-51, 54, 55, 57-85, 89-100, 103-106, 109-112, 114, 119, 122, and 143.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 3, 4, 7-17, 19-42, 44-50, 51, 54, 55, 57-60, 62-67, 69-73, 75-85, 89-100, 103-106, 109-112, 114, 119, 122, and 143 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,522,857 issued to HIGGINS in view of 5,610,207 issued to DE SIMONE et al. and in further view of US 5,540,968 issued to HIGGINS as set forth in previous Office Actions.

Applicant has amended the claims to limit the rebond foam cushion to comprising foam chips and binder. Said amendment is insufficient to overcome the standing rejection since the cited prior art of DeSimone teaches rebond foam comprising foam chips and binder.

4. Claims 5, 6, 18, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over both of the cited HIGGINS patents and the DE SIMONE patent as set forth above, and in further view of EP 048 986 issued to DOW for the reasons of record.

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5. Claims 61, 68, and 74 stand rejected under 35 U.S.C. 103(a) as being unpatentable over both of the cited HIGGINS patents and the DE SIMONE patent as set forth above, and in further view of US 5,616,200 issued to HAMILTON for the reasons of record.

Response to Arguments

6. Applicant's arguments filed with the amendment and the Norton Declaration have been fully considered but they are not persuasive. Specifically, applicant asserts the evidence as a whole shows it is more probable than not at the time of the invention that one skilled in the art would not have found it obvious to substitute a rebond foam layer as taught by DeSimone for the foam layer of Higgins. Applicant relies on the noted Norton Declaration in support of this argument.

7. In response, it is first noted that the Norton Declaration does not present any quantitative data showing unexpected results, but merely reiterates that the accepted wisdom in the art was that rebond foam was not suited for carpet tiles. Secondly, the examiner respectfully disagrees that the previous Kilpatrick Declarations and/or said Norton Declaration is sufficient to show nonobviousness. Indeed, MPEP 2145 states that proceeding contrary to accepted wisdom in the art is evidence of nonobviousness. In particular, *In re Hedges*, 228 USPQ 685 held that the "PTO acted erroneously in determining that claimed process for sulfonating diphenol sulfone at its molten state would be obvious from prior art, *since* references all suggest that lower temperatures are preferable, and *none suggests that reaction may be advantageously produced at molten state*, and *since data produced by inventor*, and not challenged by PTO, *show significant advantages of claimed invention*, so that, on balance, inventor proceeded contrary to accepted

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wisdom, which is strong evidence of unobviousness.” [Emphasis added.] Additionally, *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, states “On the entire record and in view of all the references, each in its entirety, it is clear that a person of ordinary skill confronted with a PTFE tape breakage problem would have either slowed the rate of stretching or increased the temperature to decrease the crystallinity. Dr. Gore did neither. He proceeded contrary to the accepted wisdom of the prior art by dramatically increasing the rate and length of stretch *and* retaining crystallinity. That fact is strong evidence of nonobviousness.”

8. The differences between the *Hedges* and *Gore* situations and the present invention are (1) the present prior art of record (i.e., DeSimone) explicitly teaches rebond foam employed as a carpet backing and (2) both the *Hedges* and *Gore* cases showed advantageous results were achieved when proceeding contrary to the accepted wisdom. Proceeding contrary to the accepted wisdom in the art is not sufficient to show nonobviousness—especially when the prior art has an explicit teaching thereto. However, the successful results achieved *are what is contrary* to the accepted wisdom. One skilled in the art would expect rebond foam to produce a commercially unsuccessful carpet tile due to the lack of uniformity in thickness and density. This is the accepted wisdom in the art. But, *proceeding contrary* to the accepted wisdom *to achieve advantageous or unexpected results* is evidence of nonobviousness. Thus, applicant is requested to provide sufficient evidence of said advantageous results as described in the last Office Action.

9. It is recommended that applicant submit a signed declaration describing in detail the construction of each carpet tile (e.g., face yarn composition and denier, face weight, thickness, and density, primary backing construction and weight, pre-coat layer composition and weight, hot melt composition and weight, reinforcement layer construction and weight, foam cushion

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back composition, weight, thickness, and density, and backing layer construction and weight).

Said declaration should also include the results of performance tests that reflect the cushion layer of the carpet tile (e.g., cushion resilience, Herzog walking comfort rating, castor chair test, Gmax, etc.). It is noted that the scope of said declaration would establish the scope of allowable subject matter. For example, if the two carpet tiles are equivalent in all aspects except the foam composition (i.e., thickness and density of foam are alike), then the allowable subject matter would be a carpet tile having a rebond foam backing. However, say the two carpet tiles differ with respect to the foam layer composition and average foam density, then the scope of the allowable subject matter would be a carpet tile having the rebond foam layer and a specified foam density.

10. Also note that the examiner is not necessarily requesting applicant conduct a new series of comparative performance tests, but rather is merely asking for clarification of data presented in specifications of related applications. [Note applicant asserts on page 20 of the Amendment, 4th paragraph, the present application compares the present invention with Milliken Comfort Plus carpet tiles. However, the present disclosure does not mention Milliken Comfort Plus[®] tile or a comparison of the present invention to any other carpet tile.] For example, in at least related application 10/118,059 at pages 87-92 states Milliken Comfort Plus[®] cushion-backed carpet tile has performance characteristics at least on par with the rebond cushion backed carpet tile of the present invention. However, the exact constructions of both carpet samples with respect to materials, weights, thicknesses, densities, etc. are not given. Hence, it is not clear if the unexpected equivalent performances are due to the rebond foam layer and not any other factor

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(e.g., reinforcing layer, hot melt adhesive, foam density, etc.) alone or in combination with the rebond foam.

11. Applicant also traverses the above rejections by arguing that DeSimone is not directed to carpet tile or even attached cushion broadloom carpet, but rather to a foam pad for carpeting (Amendment, page 21). In response, the examiner respectfully disagrees. Specifically, DeSimone teaches a rebond polyurethane foam product which is suited for a carpet backing (abstract and col. 2, lines 34-45). DeSimone employs the term “carpet backing” rather than carpet pad, underlay, or other common term used to describe a non-attached foam layer for placement under an installed carpet. As such, the examiner believes the DeSimone reference clearly teaches one skilled in the art that the rebond foam is suited for attachment as a carpet backing layer.

12. Applicant also states, “As described earlier and as agreed to by the Examiner, it would not have been obvious to substitute rebond foam for the virgin foam in a carpet tile.” (Amendment, page 21, 2nd paragraph). It appears applicant is confusing the examiner’s words since the rejection of record is based upon the obviousness of substituting a rebond foam layer as taught by DeSimone for the foam layer of Higgins ‘857.

13. Regarding applicant’s arguments that changes to a dimensionally stable carpet tile are viewed with skepticism (Amendment, page 22, 1st paragraph), it is argued that the layers of a carpet tile in question (i.e., primary carpet face, adhesive, and cushion back) are not necessarily the layers instrumental to dimensional stability. Specifically, the face is intended to be decorative and aesthetically pleasing, while appearing durable to wear. The main function of a polyurethane foam layer is to provide a resilient cushion backing for comfort upon use. The

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adhesive layer is employed to bind the face yarns and to adhere the cushion back to the primary carpet face. Hence, none of the layers contribute significantly to obtaining a dimensionally stable carpet tile and changes thereto need not be devastating to the stability of said carpet tile as asserted by applicant (Brief, page 8, 1st paragraph). In carpet tiles, this function is largely obtained by the use of a stabilizing or reinforcement layer such as a fiber glass scrim. Note Higgins '857 col. 1, lines 48-55 and Higgins '968 col. 3, line 64 - col. 4, line 7. In at least independent claim 1, applicant is not claiming any reinforcement layer or any properties reflecting the dimensional stability of the carpet tile. Thus, applicant's arguments are not necessarily commensurate in scope with the claims.

14. Applicant also argues that one skilled in the art would not remove one of the two stabilizing layers of Higgins '857 (Amendment, page 22, 4th paragraph). In response, it is first noted that the reinforcement layer 158 of Higgins '968 corresponds to the carrier layer 26 of Higgins '857. Secondly, Higgins '968 explicitly states "the reinforcement material 158 may be left completely out of the process" (col. 6, lines 43-49). Thus, applicant's argument is found unpersuasive.

15. With respect to applicant's assertion of the "preponderance of evidence" that outweighs a conclusion of obviousness (Amendment, page 23-25), it is asserted, as explained above, that applicant has not provided said "preponderance of evidence" outweighing said conclusion of obviousness. The cited prior art suggests the invention as presently claimed. Additionally, the Kilpatrick and Norton declarations have not been found persuasive of non-obviousness for the reasons set forth above.

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16. With the present amendment, applicant submits “a sample of a commercial carpet tile representative of copying by others” (Amendment, page 25, 2nd paragraph). Said sample is “a rebond foam backed carpet tile made and sold in 2004 in Europe by a competitor of Milliken & Company” (Amendment, page 25, 2nd paragraph). “Applicants respectfully believe this to be sufficient evidence of copying by others which is one of the nonobviousness and patentability factors to be considered.” (Amendment, page 25, 2nd paragraph). The examiner respectfully disagrees. First, the sample is not labeled or documented in any way as to the carpet construction and source thereof. Said sample is merely labeled with the present application number. Secondly, without details of the construction of said carpet sample, the examiner cannot possibly verify it as “copying” of the present invention. The Patent Office does not have the capability for analysis of samples. Thirdly, with respect to applicant’s evidence of copying, more than the mere fact of copying is necessary to make that action significant because copying may be attributable to other factors (see MPEP 716.06). Alleged copying is not persuasive of nonobviousness when the other manufacturer had not expended great effort to develop its own solution. *Pentec, Inc. v. Graphic Controls Corp.*, 227 USPQ 766. Therefore, applicant’s submission of a sample of “copying” is not found persuasive and the above rejections are maintained.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cj
February 9, 2006

CHERYL A. JUSKA
PRIMARY EXAMINER

